Robert Fisher, Chicago Operations Office
Dickson Kehl, Albuquerque Operations Office
Emily Schneider, Oak Ride Operations Office
Lisa Jarr, National Energy Technology Laboratory

Filing A Patent Application On A National Security Classified Invention Disclosure

Summary

The reasons for the Government filing a patent application on a national security classified invention disclosure are the same as those for filing on an unclassified invention disclosure. While a national security classification is one reason not to file a patent application, there may be other reasons that support a decision that filing a national security classified patent application is in the Government's best interest. A patent application establishes present and future Government property rights. Failure to file forfeits those property rights and could lead to disputes over rights, litigation, costs and damages assessed against the Government.

Purpose of this Internal Patent Instruction (IPI)

Pursuant to 42 U.S.C. 5908(b) and DOE's implementing regulations, contractors are required to report all inventions to DOE, including classified inventions. The purpose of the present IPI IV-01-04 is to provide guidance to Department of Energy (DOE) and intellectual property counsel for evaluating whether or not to file a patent application on behalf of the Government on a national security classified invention disclosure.

Reasons For Filing A Patent Application On A Classified Disclosure

Patent Application Filing and Waiver Procedures are covered in Internal Patent Instruction (IPI) IV-1-95 issued April 20, 1995. The present IPI IV-01-94 supplements IV-1-95.

The reasons for filing a patent application on a national security classified invention disclosure are similar to those for filing on an unclassified invention disclosure. They are summarized as follows:

1. Actual or potential commercial use of the invention

A patent application establishes a property right in technology developed at taxpayer expense.

Significant commercial use of the invention is often sufficient reason for filing a classified patent application. Potential commercial use may also justify filing.

National security classification may indicate the absence of present commercial use and weighs against filing. However, the potential for future commercial use should be considered. There have been classified technologies in which the Government has been the primary sponsor of research and for which commercial use developed later. The Government may want to assert and maintain ownership so that a group of accumulated invention rights covering an identified technology can be transferred to a party interested in bringing the technology into commercial use. Uranium enrichment research is an example.

Filing may be considered for inventions in a technology that is presently national security classified but which may be declassified in the near future. For example, Department of Homeland Security has inventions, such as those relating to passenger screening and detection of contraband, that may initially be classified, but may be declassified as part of a deployment strategy as the inventions are introduced into the civilian marketplace.

Classified technologies can be commercially licensed. The unclassified product of a classified process may be sold commercially or used by the Government without revealing the classified process.

2. Defensive purposes

A patent application establishes that the Government did not abandon, suppress or conceal the invention, 35 U.S.C. 102(g).

A patent application prevents others from obtaining a patent on the same invention or demanding royalties from the Government for use of the invention, 42 U.S.C. 2183(g).

A patent application indicates the owner considers that the discovery is not the equivalent of other patented inventions in the same technology. A patent application may be useful as a defense against a claim of patent infringement under the doctrine of equivalents in the future.

A patent application is a constructive reduction to practice of the invention and establishes the date the inventor was in full possession of the invention. It also establishes inventorship in collaborative research.

Although it is not published or disseminated, a classified patent application is prior art against later filed patent applications, 42 U.S.C. 2185.

Actual Government use and extent of use of an invention are considerations which should be taken into account in deciding whether filing a patent application on a classified invention disclosure is in the Government's best interest.

3. The advancement of science and technology

A patent application memorializes a pioneering invention and the inventor. A patent application is one of the few ways to document the progress of science and technology in historically classified technologies.

4. Special purposes and incidental benefits to DOE laboratories and to the public

Research collaboration between DOE employees, contractor employees and outside parties may generate questions of scope of invention and inventorship. Filing a patent application may assist in resolving such questions and countering any patent application filed by an outside party. DOE may be obligated to seek patents on inventions under international agreements.

Classified Invention Disclosures and Patent Applications

Department of Energy (DOE), National Aeronautics and Space Administration (NASA), and Department of Defense (DOD) review their own invention disclosures and apply security classification markings under their own security review guidelines. Any patent application prepared from a classified invention disclosure is reviewed and marked as required with a national security classification: "Confidential", "Secret" or "Top Secret." A marked patent application is filed in the Patent Office by hand carrying or mailing it to the Patent Office Licensing and Review Office.

The U.S. Patent Office screens every domestic provisional patent application, non-provisional patent application and international application filed in the U.S. Patent Office under the Patent Cooperation Treaty (PCT) for security classification as provided for under the Atomic Energy Act, 42 U.S.C. 2181 (c) and (d).

The Patent Office holds a patent application requiring additional scrutiny in the Licensing and Review Office for security review by classifiers from the Department of Energy (DOE), National Aeronautics and Space Administration (NASA), and Department of Defense (DOD). A patent application with a national security classification is passed to Art Unit 3600 for examination by a patent examiner holding the required security clearance.

Examination of a Classified Patent Application

A classified patent application proceeds through examination the same as an unclassified patent application until it is held allowable, 37 CFR 5.3. Issuance of an allowed, classified patent application is held in abeyance until the application is declassified by the original classifying Agency, 42 U.S.C. 2181(e). Allowed, classified applications are reviewed for declassification annually, 35 U.S.C. 181, and on petition for rescission or removal of secrecy order, 37 CFR 5.4.

Allowed classified applications for which there is no civilian use, such as those relating to nuclear weapons and naval nuclear reactors, are not often declassified. In contrast, classified applications for inventions that have utility in the civilian marketplace or for which the technology has entered the public domain may be declassified. Commercial need and public knowledge of the technology are valid reasons for declassification.

Issuance

When an entire technology is declassified, allowed patent applications in that technology should be reviewed for declassification.

When an allowed patent application is declassified, the Assistant General Counsel for Technology Transfer and Intellectual Property files a letter for Rescission of the Secrecy Order. The U.S Patent Office then resumes processing the application and normally issues a Notice of Allowance and Issue Fee Due.

It is DOE policy to pay the Issue Fee and allow a declassified patent application to issue. Issuance of the patent makes public the contributions of the inventors and the rights of the Government in the invention, even after a significant period of time has passed since the classified application was filed.

Reasonable efforts should be made to locate the inventors, or their immediate families, in order to forward to them a copy of the issued patent in appreciation of their efforts on behalf of the Government, and to authorize and provide to them any payments or awards which may be due to an inventor upon issue of a patent.

When patent maintenance fees become due on the declassified patent, no special consideration is given in the decision of whether to maintain the patent in force or not. The age of the technology and actual use by the Government are the primary considerations.

Paul A. Gottlieb
Assistant General Counsel
for Technology Transfer
and Intellectual Property